

R E M A R K S

- Claims 1 - 72 and 74 – 118 are pending in the present application.
- Claims 1 – 72 and 74 - 118 stand rejected under 35 U.S.C. §103(a).
- Of the pending claims, only claims 1, 2, 9, 11, 13, 15, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, and 108 are independent.
- Each of the above-listed independent claims has been amended herein.
- Claims 119 – 126 have been added herein. No new matter has been added, as explained below.
- Upon entry of this Response and Amendment, which is respectfully requested for the reasons set forth below, claims 1 – 72 and 74 – 126 will be pending.

Claims 1 – 72 and 74 – 118 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,897,622 to Blinn et al. (“Blinn” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

1. Independent claims 1, 2, 9, 11, 13, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, and 108

Each of the independent claims 1, 2, 9, 11, 13, 17, 19, 22, 28, 30, 33, 35, 47, 48, 74, and 108 has been amended herein to recite the following claim feature, which is not taught or suggested by any of the prior art of record:

wherein at least one of the at least one secondary product is selected for inclusion in the package based on an indication of interest, by the customer, in the at least one secondary product

Blinn in particular does not teach or suggest the above feature. Rather, Blinn is limited to offering to a customer a cross-sell product that is associated in a database with the product selected for purchase by the customer. See, for example, column 21, line 62 through column 22, line 45 and Fig. 13B. There is no description or hint in Blinn of selecting a cross-sell product based on an indication of interest in the cross-sell product by the customer. Only cross-sell products that a merchant had previously associated in a database with the product selected for purchase by the customer are offered to the customer in Blinn, irrespective of whether the customer had indicated any interest in the cross-sell product in the database.

Further, since Blinn is strictly database-driven and there is no description or enablement in Blinn of tracking a customer’s interest in a for any purpose, much less for the purpose of later

including the product in a package being offered to the customer, it would not be obvious to modify **Blinn** to include such a feature.

2. Dependent Claims

Since each of the pending dependent claims are dependent from an independent claim that includes the above-discussed feature, each of the dependent claims includes the feature and is patentable at least for the same reasons as discussed in section 1 above.

Further, many of the pending dependent claims are additionally patentable because they include features not taught or suggested by the prior art, as discussed below.

2(a) Dependent claims 3, 50, and 75

Each of the dependent claims **3, 50 and 75** recites the following feature, which is not described or suggested by **Blinn** or any other prior art of record:

“detecting that the primary product is of interest to the customer comprises detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a pre-determined amount of time” (emphasis added)

Since “detecting that the primary product is of interest to the customer” causes a package to be presented to the customer, in the embodiments of claims **3, 50 and 75** “detecting that information relating to the primary product is displayed on a web-page viewed by the customer for a predetermined amount of time” causes a package including the primary product and at least one secondary product to be presented to the customer. Thus, for example, if a customer views a web page that displays information on a product for at least one minute, it may be inferred that the customer is interested in the product but still undecided about purchasing it. That may be an opportune time to present the customer with an offer for a package that includes the product and one or more additional products, as an incentive to the customer to purchase the product.

The method of **Blinn** does not allow a retailer to take advantage of such an opportunity. **Blinn** merely describes that when a customer selects a product for purchase, a cross-sell product may be offered to the customer. **Blinn** does not describe determining an amount of time that information relating to a product is displayed on a web-page viewed by the customer, much less presenting a package to the customer if the amount of time is a pre-determined amount of time.

2(b) Dependent claims 7, 79 and 117

Each of dependent claims **7, 79 and 117** recites the following feature, which is not described or suggested by **Blinn** or any other prior art of record:

“wherein the input signal indicating an interest in the primary product comprises a request for a package associated with the primary product” (emphasis added)

In other words, a customer may expressly request that a package be presented. **Blinn** does not describe or suggest such a feature. In **Blinn**, the program module follows the same steps with

every order: it checks whether an item selected for purchase has an associated cross-sell item in a database and, if so, presents the cross-sell item to the customer. See, for example, 21, line 62 through column 22, line 45. A customer has no control or input as to whether a cross-sell item will be presented in *Blinn*.

2(c). Dependent claims 12, 61 and 82

Each of the dependent claims **12, 61 and 82** recites the following claim feature, which is not described or suggested by *Blinn* or any other prior art of record:

“selecting the at least one secondary product from a plurality of available secondary products stored in the database *based on [a] profit margin” of the primary product and / or the profit margin of the at least one secondary product*” (emphasis added)

Again, *Blinn* in particular only describes retrieving from a database a cross-sell product that is associated with the product selected for purchase by the customer. *Blinn* does not describe or suggest selecting the cross-sell product based on any factor other than it being associated with the product selected for purchase, much less selecting it based on a profit margin (whether it be a profit margin of the product selected for purchase by the customer or the profit margin of the cross-sell product).

2(d). Dependent claims 44, 45, 46, 69, 70, 71, 72, 105, 106, 107 and 118

Each of the dependent claims **44, 45, 46, 69, 70, 71, 72, 105, 106, 107 and 118** recites that the products included in the package offered to a customer may be offered by a plurality of different retailers. Neither *Blinn* or any other prior art of record describes or suggests such a feature. Specifically, in *Blinn*, although a plurality of retailers may participate in the system, the product that is selected for purchase by a customer and the cross-sell product that may be offered to a customer are sold by the same retailer. *Blinn* certainly does not describe or enable “distributing an appropriate portion of the charged package price to each of the first retailer and the second retailer” as is claimed in claim **46**.

2(e). Dependent claims 29, 31, 34, 94, 95 and 96

Each of dependent claims **29, 31, 34, 94, 95 and 96** recites the following feature, which is not described or suggested by any of the prior art of record:

“wherein the package offer comprises an offer for sale of *a [customer-selected or pre-determined] number of the secondary products*, selected by the customer, *at the package price*” (emphasis added)

Blinn, in particular, does not describe or suggest the above feature. *Blinn* merely describes that a cross-sell product may be offered to the customer when the customer selects a product for purchase. *Blinn* does not describe presenting to the customer a selection of cross-sell products, where the customer may select a number of the cross-sell products for a particular package price. Even if *Blinn* were interpreted as describing that more than one cross-sell product may be offered to the customer, *Blinn* does not describe allowing the customer to select a number of the cross-sell products for a particular package price. Rather, the total price that a customer

would pay for selecting more than one cross-sell product would vary based on the individual prices of the cross-sell products selected. In contrast, in the claimed embodiments the package price may remain unaffected by the particular secondary products selected.

2(f). Dependent claims 34 and 96

Each of the dependent claims **34 and 96** recites the following feature, which is not described or suggested by any of the prior art of record:

“wherein the package comprises the primary product and a plurality of lists of secondary products, and wherein the package offer comprises an offer for sale of a pre-determined number of the secondary products selected by the customer from each of the plurality of lists, at the package price” (emphasis added)

For example, a package may include a primary product “A” and a first list “1” that includes products “B” and “C” and a second list “2” that includes products “D” and “E”. The customer may be presented with an offer to purchase product “A” plus one of the products from list “1” and one product from list “2”, all for the price of \$25. Thus, the customer could select to purchase products “A”, “B” and “D” for \$25 or products “A”, “B” and “E” for \$25 or products “A”, “C” and “D” for \$25 or products “A”, “C” and “E” for \$25. Neither Blinn or any other prior art of record teaches or suggests such an embodiment. As discussed above, Blinn merely describes offering a customer a cross-sell product once the customer selects a product for purchase. Blinn does not describe allowing the customer to select more than one cross-sell product, much less allowing the customer to select one product from each of a plurality of lists of products, much less allowing the customer to do so all for a particular package price.

2(g). Dependent claims 16, 63 and 84

Each of the dependent claims **16, 63 and 84** recites the following feature, which is not taught or suggested by any of the prior art of record:

selecting at least one of the secondary product to be included in the package based on a relationship of the at least one secondary product to a product previously sold to the customer (emphasis added)

Thus, for example, irrespective of the primary product that the customer may currently be interested in or selecting for purchase, at least one of the secondary products to be included in the package to be offered to the customer is selected based on a product previously sold to the customer. Blinn, in particular, does not describe or suggest the above feature. As discussed above, Blinn merely describes presenting a cross-sell product to a customer, if that cross-sell product has been associated in a database with the product currently selected for purchase by a customer. There is no discussion or hint of taking a customer’s previous purchases into account for any purpose in Blinn, much less of doing so to select a product for inclusion in a package to be offered to the customer.

2(h). Dependent claims 24, 89, and 92

Each of the dependent claims **24, 89 and 92** recites the following feature, which is not described or suggested by any of the prior art of record:

“in response to the customer [rejection of the package], determining another package to be offered to the customer”

Blinn, in particular, does not describe or suggest determining another cross-sell product if a customer rejects an offer of a first cross-sell product. In **Blinn**, any and all cross-sell products associated with a product selected for purchase by the customer would be offered to the customer at the same time. **Blinn** does not describe offering only one cross-sell product and then offering another if the customer rejects the first offer. In fact, **Blinn** does not address at all what action to take if the customer rejects an offer of a cross-sell product.

2(i). Dependent claims 55, 56, 70, 71, 102

Each of the dependent claims **55, 56, 70, 71 and 102** recites that the package of products is obtained by visiting a retail establishment, a feature that is not described or suggested by any of the prior art of record.

Examiner acknowledges that “**Blinn** does not disclose having customers pick up each item of a package by visiting the appropriate merchant.” Current Office Action, page 4, first full paragraph. Examiner goes on to assert, however, that

“Picking up purchased item(s) at local retailers is old and well known.

Therefore, it would have been obvious to one of ordinary skill in the art of electronic commerce to permit customers to pick up one or more items of a package by visiting an item’s merchant.

One of ordinary skill in the art of electronic commerce would have been motivated to permit customers to pick up one or more items of a package by visiting an item’s merchant for the obvious reason that shopping is a delightful, pleasurable activity and merchants may wish to promote sales at local stores by inviting customers to visit.”

Examiner goes on to list various benefits that may be realized by allowing a customer to pick up one or more items of a package by visiting a retail establishment.

Applicants traverse the rejection of these claims because no prima facie case of obviousness has been established. Specifically, Applicants respectfully submit that (1) it was not known to allow customer to pick up items purchased via a web site by visiting retail establishments at the time of Applicants’ invention; and (2) no proper motivation to combine has been provided.

2(i)(1). Official Notice

Examiner appears to be taking Official Notice that “picking up [items purchased via a web site] was old and well known” at the time of Applicants’ invention. Applicants respectfully disagree. At the time of Applicants’ invention, electronic commerce was conducted

as a separate process from shopping by visiting a retail establishment. Those retailers that operated both a retail establishment and an online web site did not integrate the two modes of sales in any manner, and specifically did not allow the pick up of items purchased online at the retail establishments. The online system and the retail establishment system of a retailer at the time were not at all integrated and each system was inoperable to recognize a purchase made via the other system. If Examiner continues to maintain the position that this feature was old and well known, Applicants request, per MPEP §2144.03(C), that Examiner provide documentation supporting this position, so that Applicants may better respond to the assertion.

Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)). ... It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. MPEP 2144.03(A).

2(i)(2). Motivation To Combine

Applicants also traverse the rejection of these claims on the grounds that no prima facie case of obviousness was established because no proper motivation to combine or modify the prior art has been provided. Applicants respectfully submit that the various benefits discussed by Examiner in supporting the modification of the prior art to include the picking up of items purchased online at a retail establishment are not a proper motivation to combine that may form a prima facie case of obviousness. Rather, the mere listing of benefits that may be realized recognizes some of the advantages of Applicants' claimed invention but is not a finding of a teaching in the prior art that would have motivated one of ordinary skill in the art to make the suggested modification. A proper motivation to combine must be objectively found in the prior art itself, and not be derived from reading Applicants' disclosure.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). MPEP 2143.01

Further, since (as discussed above), allowing an item purchased online to be picked up at a retail establishment was unknown at the time of Applicants' invention, a person of ordinary skill in the art would not have been able to combine such knowledge with Blinn, since such knowledge did not exist.

Applicants further note that Blinn expressly describes in various passages that any items purchased via the Blinn system are shipped or delivered to the customer, and does not at all hint or suggest that the items may be picked up by the customer at any location, much less a retail establishment. See, for example, column 6, lines 47 – 52; column 8, lines 5 – 7; and Fig. 15A.

3. New Claims

Each of the new independent claims **119 and 123 – 126** recites that a package is offered to a customer once a loss of interest by the customer in the primary product is determined. This feature is supported by the specification as filed. See, for example, page 28, lines 6 – 12 and page 43, lines 6 – 10. The new dependent claims **120 – 122** recite examples of what may constitute an indication of a loss of interest in the primary product.

Neither Blinn or any other prior art of record describes or suggests presenting a package offer to a customer one an indication of a loss of interest in a product is determined. Blinn, in particular, is limited to describing the presentation of a cross-sell product only when a customer selects a product with which the cross-sell product is associated.

Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

Petition for Extension of Time to Respond

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. If an additional extension of time is required in addition to that requested, please grant a petition for that extension of time which is required to make this Response timely.

Please charge as follows:

Charge: \$710.00

Deposit Account: 50-0271

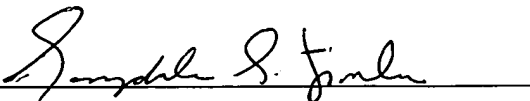
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Charge any additional fees or credit any overpayment to the same account.

A duplicate copy of this authorization is enclosed for such purposes.

Respectfully submitted,

April 01, 2004
Date


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